

Serial No. 10/611,563
Atty. Docket No. 60655.0100

REMARKS

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Applicants reply to the Office Action mailed on November 11, 2005, within the shortened statutory period for reply. Claims 1-60 were pending and the Examiner rejects claims 1-23 and 30-60 and objects to claims 24-29 as being dependent on a rejected base claim. In reply, Applicants amend claims 1, 3-4, 7-8, 10, 15, 24-31, 33, 36-44, and 46-60, cancel claims 5-6, 16-18, 20-22 and 45 without prejudice to filing one or more applications including claims with similar subject matter, add claims 61-62, and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

Claim Objections

Applicants acknowledge the indication of allowable subject matter in claims 24-29. Claim 24 was also objected to for repetition of "protocol sequence controller." Claim 24 has been amended, as suggested by the Examiner.

Claim Rejections - 35 USC § 112

Claims 16-18 and 20-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner indicated that "[i]n order to make the above claims definite, actual chemical compositions would need to be conveyed." (page 2). In the interest of furthering prosecution, Applicants cancel claims 16-18 and 20-22 without prejudice or disclaimer, rendering all rejections of these claims moot.

Claim Rejections - 35 USC § 103

Claims 1-15, 19, 23, 30-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over GB-A-1,371,254 ("Kilmer") in view of U.S. Pat. No. 5,988,510 ("Tuttle"). Applicants respectfully traverse.

Kilmer generally discloses a card having coding formed by a series of light blocking and light transmitting regions. Kilmer specifically teaches permeability "in the visible and infra red regions." (lines 42-43). Tuttle discloses, at most, a transponder associated with a transaction card. The cited references do not disclose an infrared blocking material substantially uniformly associated

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with a transparent or translucent card. Moreover, Kilmer teaches away from a uniform infrared blocking material, since Kilmer employs infrared blocking material in a particular code pattern, the purpose of which would be entirely frustrated by uniform blocking of infrared light over the card surface. This distinction was acknowledged by the Examiner in the reasons for allowance regarding Application Serial No. 09/653,837, now issued as U.S. Patent No. 6,581,839. As such, neither Kilmer, Tuttle, nor any combination thereof, teach or suggest a "machine recognizable compound containing an infrared blocking material, said machine recognizable compound substantially uniformly associated with said card layer," as recited in independent claim 1, or a "machine recognizable compound substantially uniformly associated with said card layer" as recited in independent claim 33.

Accordingly, Applicants assert that claims 1 and 33 are patentable over the cited references. Claims 2, 3, 7-15, 19, 23-32, and 34-35 variously depend from claims 1 and 33 and contain all of the elements thereof. Therefore, Applicants respectfully submit that these dependent claims are likewise differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Applicants have cancelled claims 4-6, 16-18, and 20-22 rendering all rejections of these claims moot. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-35.

Claims 36-60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kilmer as modified by Tuttle as applied to claim 1 above, in further view of U.S. Pat. No. 6,290,137 ("Kiekhaefer"). Applicants respectfully traverse.

Applicants note that Kiekhaefer was filed on October 1, 1999, which is subsequent to the September 7, 1999 filing of Provisional Application No. 60/153,112 to which this application claims priority through U.S. Patent Application Nos. 10/092,681 and 10/062,106. Thus, Kiekhaefer is not prior art and is not properly citable against this application. This point was similarly recognized by the Examiner during prosecution of Application Serial No. 09/653,837, now issued as U.S. Patent No. 6,581,839.

As argued with regards to claims 1 and 33, neither Kilmer, Tuttle, nor any combination thereof teaches or suggests "a machine recognizable compound containing an infrared blocking material substantially coextensive with said card layer," as recited in independent claim 36, a "substantially continuous IR film between two layers of PET GS," as recited in independent claim 37, a "machine recognizable compound containing an infrared blocking material substantially continuously covering said card layer, wherein said machine recognizable compound is

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substantially transmissive to visible light," as recited in independent claims 39 and 40, or "placing a substantially continuous machine recognizable compound between at least two layers of PET IR," as recited in independent claims 41 and 42.

Accordingly, Applicants assert that claims 36, 37, 39, and 40- 42 are patentable over the cited references. Claims 38 and 43-44 and 46-60 variously depend from claims 1, 33, 36, 37, 39, 40, 41, and 42 and contain all of the elements thereof. Therefore, Applicants respectfully submit that these claims are likewise differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 36-44 and 46-60.

New Claims

New claims 61 and 62 are patentable over the cited references because neither Kilmer, Tuttle, nor any combination thereof, teach or suggest a method "wherein said IR film is substantially coextensive with at least one of said two layers," as recited in dependent claim 61, or a card comprising "an infrared blocking material associated with all machine recognizable points of said card layer," as recited in independent claim 62.

CONCLUSION

Applicants respectfully submit that the pending claims (53 total, 9 independent) are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

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